

## **REMARKS**

Applicants appreciate the Office's review of the present application. In response to the Office Action, the cited references have been reviewed, and the rejections and objections made to the claims by the Examiner have been considered. The claims presently on file in the present application are believed to be patentably distinguishable over the cited references, and therefore allowance of these claims is earnestly solicited.

In order to render the claims more clear and definite, and to emphasize the patentable novelty thereof, claims 3, 5, 6, 9, 14, 19-20, and 26 have been amended, and claims 1-2, 13, 18, 21, and 25 have been cancelled without prejudice. Accordingly, all claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested.

This Amendment is submitted in order to further prosecution and permit the issuance of a patent on the allowable subject matter, and should not be construed as acquiescence by Applicants in the outstanding rejection. Applicants reserve the right to pursue the content of any cancelled claims in a continuing application.

### **Rejections**

#### **Rejection Under 35USC Section 112 Second Paragraph**

Claim 21 has been rejected under 35 USC Section 112, subparagraph 2, as being indefinite for failing to particularly point and distinctly claim the subject matter which the Applicant regards as the invention. Claim 21 has been cancelled in view of this rejection.

In view of the foregoing, it is submitted that the rejection under 35 USC Section 112, paragraph 2, has been overcome and should be withdrawn.

#### **Rejection Under 35USC Section 102(b)**

Claims 1-2, 13, 18, 19, and 25 have been rejected under 35 USC Section 102(b), as being anticipated by U.S. patent 6,871,929 to Crivelli et al. ("Crivelli"). With this Amendment, claims 1-2, 13, 18, and 25 have been canceled without prejudice. Claim 19 has been amended to depend from amended claim 20, whose reasons for patentability are discussed subsequently. Applicants therefore respectfully traverse the rejection and request reconsideration based on the amendment to claim 19 and the cancellation of the other claims.

#### Rejection Under 35USC Section 103

Claims 3 and 20 have been rejected under 35 USC Section 103(a), as being unpatentable over U.S. patent 6,871,929 to Crivelli et al. ("Crivelli") in view of U.S. patent 5,353,052 to Suzuki et al. ("Suzuki").

Applicant respectfully asserts that the Crivelli reference is not a valid prior art reference. As provided by 35 USC section 103(c) for any application filed on or after the date of enactment, November 29, 1999:

“(c)(1) Subject matter developed by another person, which qualifies as prior art only under one or more of sub-sections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.”

The Examiner will note that the Crivelli reference and the present application are assigned to the same entity. More specifically, the Crivelli reference was filed 04/12/2001, and was originally assigned by inventor Crivelli to the Hewlett-Packard Company, *see* Reel/Frame 012507/0518 recorded 01/23/2002. The Crivelli reference was later assigned to Hewlett-Packard Development Company, L.P., *see* Reel/Frame 014061/0492 recorded 09/30/2003. The present application was filed 10/22/2003, and was assigned to Hewlett-Packard Development Company, L.P., *see* Reel/Frame 014397/0260 recorded 03/04/2004. Thus, at the time the claimed invention of the present application was made, it was owned by the same entity or subject to an obligation of assignment to the same entity as the Crivelli reference, i.e., Hewlett-Packard Development

Company, L.P.

The Crivelli reference was filed before, but did not issue until after, the present application's filing date. Therefore, the disclosure of the Crivelli reference is available only as 35 U.S.C. § 102(e)-type prior art. In that regard, 35 U.S.C. § 103(c) now provides that the Crivelli reference "shall not preclude patentability" of the claimed invention.

Therefore, the rejection of claims 3 and 20, rewritten herein in independent form, is improper at least for this reason and should be withdrawn.

### **Formalities**

#### **Amendment of the Specification**

Page 8 of the specification has been amended to add reference character 424 to the description, to address the Office's objection to the drawings.

#### **Amendments to the Claims**

Claims 5 and 6 have been objected to for the informality of a possible interpretation as claiming that the device prints the second swath at a temperature near 0 degrees C. Claims 5 and 6 have been amended, as required by the Office, to render the claims more clear and definite.

#### **Allowable Subject Matter**

Claims 4-12, 14-17, 22-24, and 26-29 have been objected to as being dependent upon a rejected base claim and have been indicated as being allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims.

Claims 4-8 depend directly or indirectly from rewritten independent claim 3. As rewritten claim 3 is now believed to be in allowable form for the reasons stated above, Applicants respectfully submit that dependent claims 4-8 are allowable in dependent form.

With this Amendment, allowable claim 9 has been rewritten in independent form to

include all of the limitations of the base claim (claim 1) and any intervening claims (none). As rewritten claim 9 is now believed to be in allowable form, Applicants respectfully submit that dependent claims 10-12 are allowable in dependent form.

With this Amendment, allowable claim 14 has been rewritten in independent form to include all of the limitations of the base claim (claim 13) and any intervening claims (none). As rewritten claim 14 is now believed to be in allowable form, Applicants respectfully submit that dependent claims 15-17 are allowable in dependent form.

Claims 22-24 depend directly or indirectly from rewritten independent claim 20. As rewritten claim 20 is now believed to be in allowable form for the reasons stated above, Applicants respectfully submit that dependent claims 22-24 are allowable in dependent form.

With this Amendment, allowable claim 26 has been rewritten in independent form to include all of the limitations of the base claim (claim 25) and any intervening claims (none). As rewritten claim 26 is now believed to be in allowable form, Applicants respectfully submit that dependent claims 27-29 are allowable in dependent form.

Applicants, therefore, respectfully request that the objection to claims 4-12, 14-17, 22-24, and 26-29 be withdrawn and that these claims be allowed.

#### Comments on Statement of Reasons for Allowance

Applicants agree with the Office's conclusion regarding patentability, without necessarily agreeing with or acquiescing in the reason(s) set forth in the Office Action. In particular, applicants wish to emphasize that the patentability of claims stems from the respective combinations of elements defined by the claims, each viewed as a whole, rather than the presence of any particular element(s) in the combinations. Applicants submit that the indicated claims are allowable because the prior art fails to anticipate, teach, suggest, or render obvious the invention as claimed, independent of how the invention is paraphrased. Applicants thus rely on the claims, as drafted, rather than any characterization in the Office Action.

**Conclusion**

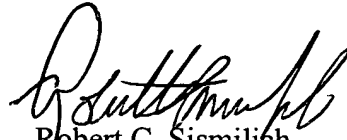
Attorney for Applicant(s) has carefully reviewed each one of the cited references made of record and not relied upon, and believes that the claims presently on file in the subject application patentably distinguish thereover, either taken alone or in combination with one another.

Therefore, all claims presently on file in the subject application are in condition for immediate allowance, and such action is respectfully requested. If it is felt for any reason that direct communication with Applicant's attorney would serve to advance prosecution of this case to finality, the Examiner is invited to call the undersigned Robert C. Sismilich, Esq. at the below-listed telephone number.

**AUTHORIZATION TO PAY AND PETITION  
FOR THE ACCEPTANCE OF ANY NECESSARY FEES**

If any charges or fees must be paid in connection with the foregoing communication (including but not limited to the payment of an extension fee or issue fees), or if any overpayment is to be refunded in connection with the above-identified application, any such charges or fees, or any such overpayment, may be respectively paid out of, or into, the Deposit Account No. 08-2025 of Hewlett-Packard Company. If any such payment also requires Petition or Extension Request, please construe this authorization to pay as the necessary Petition or Request which is required to accompany the payment.

Respectfully submitted,



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